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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/651,406	08/30/2000	James C. Monberg	2590	9956

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EXAMINER

MAHMOUDI, HASSAN

ART UNIT	PAPER NUMBER
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2175

DATE MAILED: 04/09/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/651,406

Applicant(s)

MONBERG ET AL.

Examiner

Tony Mahmoudi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 23 January 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DOV POPOVICI

PROVISIONAL PATENT EXAMINER
PHY CENTER 2100

DETAILED ACTION

Remarks

1. In response to communications filed on 23-January-2003, claims 1-3, 7-14, and 20 are amended, and new claims 21-24 are added per applicants' request. Therefore, claims 1-24 are pending in the application.
2. The proposed drawing correction filed on 23-January-2003 is approved by the examiner. Corrected drawings are required in response to this office action.

Claim Objections

3. Claim 22 is objected to because of the following informalities:

All claims must end with a period. Claim 22 does not end with a period.

Correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunworth et al (U.S. patent No. 5,930,474) in view of Getchius et al (U.S. Patent No. 6,408,294.)

As to claim 1, Dunworth et al teaches in a computer system, a method (see column 2, lines 49-51) comprising:

maintaining location binding information (see column 24, lines 34-49, where “location binding information” is read on “address”, “city”, “state”, and “zip code” fields”) associating a merchant with a plurality of listed regions (see column 38, line 66 through column 39, line 5, and see figure 12), including at least one listed region in which the merchant provides service (see column 8, lines 37-44, and see column 24, lines 28-39, where “yellow pages” database is explained, and see column 37, lines 36-65);

receiving a request (see column 3, lines 1-2) directed to a particular region (see column 5, lines 22-24, and see figure 15);

searching the location binding information (see column 2, lines 54-58) associated with the merchant (see column 2, line 63 through column 3, line 14) to determine if the particular region matches at least one of the listed regions (see column 15, lines 23-25), and if so, returning information regarding the merchant (see column 16, lines 17-26, where “merchant” is read on “the specified value”.)

Dunworth et al does not teach the merchant that does not include a physical location.

Getchius et al teaches a method and system for performing online data queries, in which he teaches the merchant that does not include a physical location (see column 18, lines 1-7, where “the merchant not having a physical location” is read on “virtual business”);

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Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Dunworth et al to include the merchant that does not include a physical location.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Dunworth et al by the teaching of Getchius et al, because associating which the merchant that does not include a physical location would enable the user to obtain information about a business or a merchant who provides goods or services to the area but does not have a physical presence in that region. For example, it would make it possible to perform a search on, and obtain information about merchandise seller, "AMAZON.COM", without AMAZON's having to be physically present in the region the search is initiated from and/or the goods/services are delivered to.

As to claim 2, Dunworth et al as modified teaches wherein maintaining the location binding information (see Dunworth et al, column 24, lines 34-49, where "location binding information" is read on "address", "city", state", and "zip code" fields") comprises writing an entry into a database including information about each listed region (see Dunworth et al, column 8, line 59 through column 9, line 4, and see figure 12) and information about the merchant (see Dunworth et al, column 9, lines 55-67, where "merchant" is read on "business", and see figure 18.)

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As to claim 3, Dunworth et al as modified teaches the method further comprising returning additional information regarding the merchant (see Dunworth et al, column 3, lines 45-54, and see figure 11.)

As to claim 4, Dunworth et al as modified teaches wherein the additional information comprises text (see Dunworth et al, column 10, lines 16-28, and see column 19, lines 40-42.)

As to claim 5, Dunworth et al as modified teaches wherein the additional information comprises a glyph (see Dunworth et al, column 8, lines 25-30, and see column 10, lines 23-28, where “glyph” is read on “graphical image” and “graphical display”).

As to claim 6, Dunworth et al as modified teaches a computer-readable medium having computer executable instructions for performing the method (see Dunworth et al, Abstract, and see figures 1, 2, 2A-2C, where software interface and computer networks for the invention are mentioned/depicted. It is inherent that “computer systems” and “software interfaces” are implemented on computer-readable mediums having computer executable instructions for performing their tasks.)

As to claim 7, Dunworth et al as modified teaches wherein the plurality of listed regions (see figure 12) comprises at least one ZIP code (see Dunworth et al, column 24, lines 28-39, and see figure 17.)

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As to claim 8, Dunworth et al teaches a computer-readable medium having stored thereon a data structure (see column 4, line 66 through column 5, line 2), comprising:

a first data field (see column 18, lines 55-59, where “data fields” is read on “each of the databases described”) containing data representing information about a merchant (see column 24, lines 28-39, where “yellow pages” database is explained, and see column 37, lines 36-65); and

a second data field associated with the first data field (see column 18, lines 55-59, where “data fields” is read on “each of the databases described”) and containing location binding data (see column 24, lines 34-49, where “location binding information” is read on “address”, “city”, state”, and “zip code” fields”) representing a region in which the merchant provides service (see column 18, lines 60-66, where “geographic database” is explained, and see column 31, line 61 through column 36, line 25);

such that a search request (see column 3, lines 1-2) seeking a merchant that services a particular region is compared to the second data field to determine from the location binding data therein whether the merchant represented in the first data field services that particular region (see column 3, lines 6-14), and if so, at least some of the information about the merchant contained in the first data field may be returned in response to the search request (see column 16, lines 17-26, where “merchant” is read on “the specified value”).

Dunworth et al does not teach a region in which the merchant does not include a physical location.

Getchius et al teaches a method and system for performing online data queries, in which he teaches a region in which the merchant does not include a physical location (see column

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18, lines 1-7, where “the merchant not having a physical location” is read on “virtual business”.)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Dunworth et al to include a region in which the merchant does not include a physical location.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Dunworth et al by the teaching of Getchius et al, because including a region in which the merchant does not include a physical location, would enable the user to obtain information about a business or a merchant who provides goods or services to the area but does not have a physical presence in that region. For example, it would make it possible to perform a search on, and obtain information about merchandise seller, “AMAZON.COM”, without AMAZON’s having to be physically present in the region the search is initiated from and/or the goods/services are delivered to.

As to claim 9, Dunworth et al as modified teaches the structure further comprising a third data field, associated with the first data field (see Dunworth et al, column 18, lines 55-59, where “data fields” is read on “each of the databases described”), and including additional information regarding the merchant (see Dunworth et al, column 10, lines 16-18) but not having a physical location in the region (see Getchius et al, column 18, lines 1-7, where “the merchant not having a physical location in the region” is read on “virtual business”).

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As to claim 10, Dunworth et al as modified teaches wherein the third data field comprises text that indicates that the merchant provides service to the region but does not have a physical location in the region (see Dunworth et al, column 5, lines 40-65, where “customization of the topical information” is taught, and see figures 11 and 15.)

As to claim 11, Dunworth et al as modified teaches wherein the third data field comprises a glyph that indicates that the merchant provides service to the region but does not have a physical location in the region (see Dunworth et al, column 19, lines 64-67, where “glyph” is read on “graphical image”, and see figure 9.)

As to claim 12, Dunworth et al teaches a computer-readable medium having stored thereon a data structure (see column 4, line 66 through column 5, line 2), comprising:

a first data field (see column 18, lines 55-59, where “data fields” is read on “each of the databases described”) containing data representing information about a merchant (see column 24, lines 28-39, where “yellow pages” database is explained, and see column 37, lines 36-65);

a second data field associated with the first data field (see column 18, lines 55-59, where “data fields” is read on “each of the databases described”) and containing data representing information regarding the merchant providing service to a region (see column 24, lines 28-39, where “yellow pages” database is explained, and see column 37, lines 36-65); and

a third data field associated with the first data field and containing location binding data (see column 24, lines 34-49, where “location binding information” is read on “address”,

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“city”, state”, and “zip code” fields”) representing a region in which the merchant provides service (see column 18, lines 60-66, where “geographic database” is explained, and see column 31, line 61 through column 36, line 25);

such that a search request (see column 3, lines 1-2) seeking a merchant that services a particular region is compared to the third data field to determine from the location binding data therein whether the merchant represented in the first data field services that particular region (see column 3, lines 6-14), and if so, at least some of the information about the merchant contained in the second data field may be returned in response to the search request (see column 16, lines 17-26, where “merchant” is read on “the specified value”).)

Dunworth et al does not teach a merchant not having a physical location in the region.

Getchius et al teaches a method and system for performing online data queries, in which he teaches a merchant not having a physical location in the region (see column 18, lines 1-7, where “the merchant not having a physical location” is read on “virtual business”).)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Dunworth et al to include a merchant not having a physical location in the region.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Dunworth et al by the teaching of Getchius et al, because including a merchant not having a physical location in the region, would enable the user to obtain information about a business or a merchant who provides goods or services to the area but does not have a physical presence in that region. For example, it would make it possible to perform a search on, and obtain information about merchandise seller,

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“AMAZON.COM”, without AMAZON’s having to be physically present in the region the search is initiated from and/or the goods/services are delivered to.

As to claim 13, Dunworth et al as modified teaches wherein the second data field comprises text that indicates that the merchant provides service to the region (see Dunworth et al, column 5, lines 40-65, where “customization of the topical information” is taught, and see figures 11 and 15) but does not have a physical location in the region (see Getchius et al, column 18, lines 1-7, where “the merchant not having a physical location” is read on “virtual business”).)

As to claim 14, Dunworth et al as modified teaches wherein the second data field comprises a glyph that indicates that the merchant provides service to the region but does not have a physical location in the region (see Dunworth et al, column 19, lines 64-67, where “glyph” is read on “graphical image”, and see figure 9.)

As to claim 15, Dunworth et al teaches a method in a computer system (see column 2, lines 49-52), comprising:

submitting a search query directed to businesses, the search query including a designation of a region (see column 14, lines 14-27);

receiving a business listing in response to the search query, the business listing being associated with a merchant that provides service to the region (see column 9, line 55 through column 10, line 6); and

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receiving, along with the business listing, information regarding the fact that the merchant services the region (see column 5, lines 40-65, where “customization of the topical information” is taught, and see figures 11 and 15. Also see column 19, lines 64-67, where “graphical image” is taught, and see figure 9.)

Dunworth et al does not teach where a merchant does not have a physical location in the region.

Getchius et al teaches a method and system for performing online data queries, in which he teaches a merchant not having a physical location in the region (see column 18, lines 1-7, where “the merchant not having a physical location” is read on “virtual business”).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Dunworth et al to include a merchant that does not have a physical location in the region.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Dunworth et al by the teaching of Getchius et al, because including a merchant that does not have a physical location in the region, would enable the user to obtain information about a business or a merchant who provides goods or services to the area but does not have a physical presence in that region. For example, it would make it possible to perform a search on, and obtain information about merchandise seller, “AMAZON.COM”, without AMAZON’s having to be physically present in the region the search is initiated from and/or the goods/services are delivered to.

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As to claim 16, Dunworth et al as modified teaches the method further comprising displaying the information along with the business listing (see Dunworth et al, figures 9, 11, and 15.)

As to claim 17, Dunworth et al as modified teaches wherein the information comprises text (see Dunworth et al, column 5, lines 40-65, where “customization of the topical information” is taught, and see figures 11 and 15.)

As to claim 18, Dunworth et al as modified teaches wherein the information comprises text and a glyph (see Dunworth et al, figures 9, 11, and 15.)

As to claim 19, Dunworth et al as modified teaches wherein the information comprises a glyph (see Dunworth et al, column 19, lines 64-67, where “glyph” is read on “graphical image”, and see figure 9.)

As to claim 20, Dunworth et al teaches a computer system (see column 2, lines 49-52) comprising:

a data store for maintaining location binding information (see column 24, lines 34-49, where “location binding information” is read on “address”, “city”, state”, and “zip code” fields”) for merchants that provide service to a region (see column 24, lines 28-39, where “yellow pages” database is explained, and see column 37, lines 36-65), at least one merchant having location binding information for a region (see figure 11);

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data entry tools for entering the information in the data store (see column 3, lines 1-8, where the “organizer comprises a database”. It is inherent for databases to have data entry tools for obtaining the data for storage.)

Dunworth et al does not teach merchants that do not include a physical location in the region; and does not teach an application programming interface for ensuring that the information is stored with each merchant entered by the data entry tools.

Getchius et al teaches a method and system for performing online data queries, in which he teaches merchants that do not include a physical location in the region (see column 18, lines 1-7, where “the merchant not having a physical location” is read on “virtual business”), and further teaches an application programming interface for ensuring that the information is stored with each merchant entered by the data entry tools (see column 28, lines 26-28, and see column 58, lines 33-49, where “database preparations” and “validity” of database updates are taught.)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Dunworth et al to include merchants that do not include a physical location in the region; and to include an application programming interface for ensuring that the information is stored with each merchant entered by the data entry tools.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Dunworth et al by the teaching of Getchius et al, because including merchants that do not include a physical location in the region, would enable the user to obtain information about a business or a merchant who provides goods or

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services to the area but does not have a physical presence in that region. For example, it would make it possible to perform a search on, and obtain information about merchandise seller, "AMAZON.COM", without AMAZON's having to be physically present in the region the search is initiated from and/or the goods/services are delivered to. Also, including an application programming interface for ensuring that the information is stored with each merchant entered by the data entry tools, would allow the user to verify the data entered for each merchant and would further verify and validate database updates to ensure accurate merchant/business information is displayed to the users.

As to claim 21, Dunworth et al as modified teaches wherein the application programming interface (see Getchius et al, column 26, lines 26-28) includes rules that require each merchant in the data store to be identified as one of a mobile, territorial, or delivery type merchant (see Getchius et al, column 14, lines 3-8, where "identifying merchant in the data store" is read on "tags identifying key data items for each business", and see column 28, lines 33-58, where "rule" is read on "mapping a string corresponding to a query name", and identifying merchant in the data store" is read on "type of business service".)

As to claim 22, Dunworth et al as modified teaches wherein the application programming interface (see Getchius et al, column 26, lines 26-28) include rules that specify whether each merchant identified in the data store requires an associated glyph (see Getchius et al, figure 15, and see column 55, lines 10-17, where "glyph" is read on "multimedia blob data, such graphics, video, audio, job applets".)

As to claim 23, Dunworth et al as modified teaches wherein the application programming interface (see Getchius et al, column 26, lines 26-28) includes rules that specify whether each merchant identified in the data store requires an associated text (see Getchius et al, figure 15, and see column 55, lines 10-17, where “associated text” is read on “”structured textual information, such as business name and address”).)

As to claim 24, Dunworth et al as modified teaches a computer readable medium having computer executable instructions for performing the method of claim 15 (see Dunworth et al, Abstract, and see figures 1, 2, 2A-2C, where software interface and computer networks for the invention are mentioned/depicted. It is inherent that “computer systems” and “software interfaces” are implemented on computer-readable mediums having computer executable instructions for performing their tasks.)

Response to Arguments

6. Applicant's arguments filed on 23-January-2003 with respect to cited references have been fully considered but they are not found to be persuasive:

In response to applicants' arguments that Dunworth et al “fails to disclose the concept of maintaining information that allows a business to be located when that business does not have a physical location within a geographic area specified in a request”, the arguments have been fully considered but are not found to be persuasive, because Dunworth et al reference

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was used in combination with a secondary reference, Getchius et al, which teaches the concept of “virtual merchants/businesses”.

Getchius et al specifically mentions “Other businesses, for example, such as a florist or an airline, may not be associated with a single well-defined geographic location. A business may not have any geographic bounds, such as if it is an Internet business with a virtual storefront accessible on the Internet. Also, other businesses may be located in a particular well-defined geographic area, such as an airline with a physical presence in a particular city, but the service area which corresponds to the service offered does not correspond to the location of the business itself. To include businesses with these particularities, in addition to the “normal” business listing just described in which the geographic business location and service areas correspond, the concepts of multi-city and total-city placements have been included in this embodiment.” (see Getchius et al, column 30, lines 46-60.)

In response to applicants’ arguments that “the prior art of record does not disclose or suggest any apparent way to modify Dunworth et al to accommodate a virtual business either explicit or otherwise”, the arguments have been fully considered but are not found to be persuasive, because the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

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In this case, both cited references teach inventions that are in the same field of endeavor. The primary reference, Dunworth et al, teaches querying for business listings with physical presence in a selected region, while the secondary reference, Getchius et al, teaches querying for business listings with a physical presence as well as “virtual businesses” that provide service to a region but do not have a physical presence in the selected region.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Dunworth et al by the teaching of Getchius et al, because by doing so, the system would expand its coverage to businesses that are physically located in one region but offer goods and/or services to multiple regions, such as the “florists” and the “airline industry”, as discussed by Getchius et al (see column 30, lines 46-49.)

In response to the applicants’ arguments that “obviousness may not be established using hindsight obtained in view of the teachings or suggestions of the applicants”, the arguments have been fully considered but are not found to be persuasive, because it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

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Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Tony Mahmoudi whose telephone number is (703) 305-4887. The examiner can normally be reached on Mondays-Fridays from 08:00 am to 04:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici, can be reached at (703) 305-3830.

tm

March 25, 2003


DOV POPOVICI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100